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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/790,313

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Sadayuki Shoudai

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11/29/2006

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EXAMINER

FALASCO, LOUIS V

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,313

Applicant(s)

SHOUDAI ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,22,23,26,27,29-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,22,23,26,27,29-36 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Papers Received

1. The Amendment and Remarks filed 10/09/06 are acknowledged.

Claims

2. The claims are: 1, 22, 23, 26, 27, 29 to 36 and 38 to 42.

Statutory basis

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections

3. Claims 1, 22, 23, 26, 27, 29 to 36 and 38 to 42 are rejected under 35 U.S.C. 102 (a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Murao et al** (US 5827599) for reasons of record.
4. Claims 1 and 22, 23, 26, 27, 29 to 33, 35, 36 and 38 to 42 are rejected under 35 U.S.C. 102 (a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious

over any one of **Iida et al** (US 6627334) or **Kasuga** (JA 09-153212 / JA 11-296839) for reasons of record.

Double Patenting

5. Claims rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over US 7045228 is withdrawn in view of applicants remarks.

6. Claims 1, 22, 23, 26, 27, 29 to 33, 35, 36 and 38 to 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14, 15 and 16 (previously claims 1 and 2) of copending Application No. 10/802,134 for reasons of record.

Response to Applicant's Arguments and Amendments

Applicant's arguments filed 10/09/06 have been fully considered but they are not persuasive.

7. Applicants point out the novelty of the tape caused by a shearing and breaking of the edge of the tape. It's argued there is a lack of teaching for the magnetic recording tape product made by the mechanism of the instant *breaking force* which forms the edge of the tape particularly through forming a broken region of the cut surface on the side

with 40% to 65%, preferably 50% to 60%, of the cut surface on the side of the lower blade.

8. Applicants also point out the advantages in the tape resulting in a reduction of *peeling* and *dropouts* at tape edge regions. This is formed by a *breaking force* forming a broken region of the cut surface on the side of the tape with a lower blade 40% to 65%, preferably 50% to 60% of the cut surface on the side of the lower blade. This is argued forms a region broken by a breaking force exerted by the blades and for the tape to have a first irregular raised and depressed patterned areas and a second irregular raised and depressed pattern (page 8 of the Remarks filed 10/09/06 – corresponding to the specification at page 28 ln 10 to page 29 ln 9).

9. Applicants have argued against anticipation and obviousness as impermissible hindsight.

Examiner's Response to Arguments

10. In response to the arguments concerning the limitations of shearing and breaking of the edge of the tape as the product of processing steps: applicants have acknowledged the prior art shapes do seem similar to what has been claimed as a result of 40-65% or 50-60% of the lower blade by comparing the profile obtained in the prior art (paragraph bridging pages 8 and 9 - Remarks filed 10/09/06), though contrast the prior art with the shape of the edge in the specification at pg 26 through 29 and Working Examples 1 and 2. However applicants have not shown the 40-65% or 50-60%

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(dependant claim 26) broken region would perform unobviously or even differently from the prior art. Where the only differences between the prior art and claims are recitations of relative dimensions it has long been held that it would be reasonably obvious for one of ordinary skill to routinely optimize the relative dimensions.

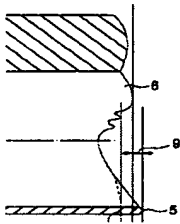
Applicants must clearly establish that what has been claimed would perform unobviously, *Gardner v. TEC Systems, Inc.*, 220 USPQ 777, 225 USPQ 232 (1984), and would not be merely a matter of choice, *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), with properties inherent in the prior art product *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

11. The instant claims are not limited as the referenced specification pg 26 – 29 and Working Examples by applicants where a tape edge having the profile of instant **Fig 6** is produced. What has been claimed is significantly broader in scope and the rejections of claims have been maintained. The instant claimed tape (1) does not require the 1st projected area of the edge to be at the back coat nor (2) the 2nd projected area of the edge to be at the center of the computer magnetic tape edge – also noted in the instant specification as explained at pg 24 ln 26 to pg 25 ln 18 of the specification, nor are there any limitations on the cutting angle required by the showing at instant TABLE 1 nor have objective evidence been submitted for justifying the for the conclusion that reduction of peeling and dropping offs from the tape.

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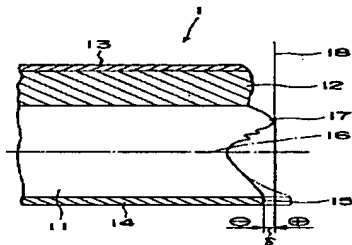
12. What has been claimed is taught by **Murao et al**, **Iida et al**, or **Kasuga** (noting also center line inserted in the Figs. and 'Drawings' citing **Murao et al** and **Kasuga** the previous Office action).

a. In **Murao et al** see magnetic tape as exemplified in Fig. 1, i.e. :



. Here irregular raised and depressed patterned areas appear at item 5 and adjacent item 9, with a second region and have a second irregular raised and depressed pattern appearing above item 9 and item 6. As regard claim 32-36 and 38-42: in **Murao et al** there is a first sheared region adjacent the back coat appears at item 5 and a second sheared region adjacent the magnetic recording layer at item 6.

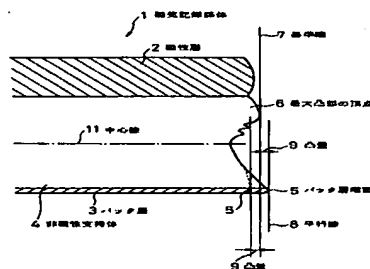
b. In **Kasuga** (JA 11-296839) see magnetic tape exemplified the 'Drawing'



i.e.: . Here a first region irregular raised and depressed patterned area appear at item 15 and adjacent item 16 with a second region, possessing a second irregular raised and depressed pattern, appearing above and below item 17. As regard claim 32-36 and 38-42: in **Kasuga** there is a

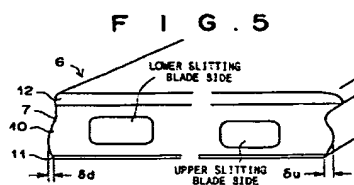
first sheared region adjacent the back coat appearing at item 15 and a second sheared region adjacent the magnetic recording layer above item 17.

c. In **Kasuga JA 09-153212** see magnetic tape exemplified in the 'Drawing'



i.e. : . Here a first irregular raised and depressed patterned area appears at item 5 and adjacent item 9 with a second region, having a second irregular raised and depressed pattern, appearing above and below item 6. As regard claim 32-36 and 38-42: in **Kasuga** there is a first sheared region adjacent the back coat appears above item 5 and a second sheared region adjacent the magnetic recording layer at item 6.

d. In **Iida et al** see magnetic tape exemplified in the tape shown in Fig. 5 i.e. :



. Here a first irregular raised and depressed patterned area appears at item 11 and below item 10 with a second region, having a second irregular raised and depressed pattern, appearing above and item 7 and below item 12. As regard claim 32-36 and 38-42: in **Iida et al** there is a first sheared region adjacent the back coat appearing at item 11 and a second sheared region adjacent the magnetic recording layer above item 7.

13. In response to the arguments concerning 'impermissible hindsight': while any judgment of obviousness may be in a sense a reconstruction the art taught the tape at the time of the invention since the rejections have only taken into account knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made - no where has applicants pointed out precisely where the examiner included knowledge gleaned only from applicant's disclosure - e.g., *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971), etc.

14. In response to the arguments concerning the double patenting rejection over the claims of copending Application No. 10/802,134: Applicants argue that pending SN 10/802,134 has a later filing date and has not yet matured to a patent and so has refrained from filing a Terminal Disclaimer. However, the side-by-side comparison of the products illustrated in instant application and that claimed in SN 10/802,134 illustrated in copending Application No. 10/802,134 at Fig. 5 exhibit a mutual, therefore, two way obviousness. See MPEP 804 II. b.

Conclusion

The claims are 1, 22, 23, 26, 27, 29 to 36 and 38 to 42.

- All claims remain rejected.

- No claim has been allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/06



CAROL CHANEY
SUPERVISORY PATENT EXAMINER